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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,831	12/12/2001	Mark Andrew Boys	P1364	7488

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CENTRAL COAST PATENT AGENCY  
PO BOX 187  
AROMAS, CA 95004

EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/016,831

Applicant(s)

BOYS, MARK ANDREW

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-24 are drawn to a system for making charitable donations, classified in class 705, subclass 1.
  - II. Claims 25 and 26 are drawn to a banking system, class 235, subclass 379

2. Newly submitted claims 24 and 25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as fund raising, while invention II has separate utility such as electronic wallets automatically receiving a direct deposit from the wallet holder's employer. See MPEP, 806.05(d).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25 and 26 are

withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP, 821.03. Applicant is respectfully requested to cancel the non-elected claims in response to this office action.

3. Claims 1-24 have been examined.

### ***Response to Amendments/Arguments***

4. Applicant has amended the claims to recite "a data store accessible to the server and storing information about individuals or families...". Previously the claim 1 recited "a data store accessible to the server and storing information about potential recipients". To one of ordinary skill, however, individuals or families are "recipients". Therefore, an obvious modification to the teaching of Gruber et al. would be to a charitable organization (figures 8 and 9) that represents a specific individual or family needing to raise money to pay for a family member's operation. Further, in order to pay for a surgery ( or promote arthritis research, save the whales, encourage reading, etc.) the family would need to access any donated funds therefore, Gruber et al. also teaches or at least clearly suggests withdrawing the funds.

Applicant recites software executing on a server (see claim 1, paragraph 3; claims 5-8) to enable the server to perform tasks such as the selection of one

or more pre-qualified individuals or families. However, these tasks are never actually performed and the software merely enables the task to occur or potentially occur ("to be", "may be" or "enable" language). To one of ordinary skill, a server is a computer, and a computer utilizes software such as an operating system, that *enables* the server to be *programmed* to perform numerous tasks (e.g. search databases, pay for goods and services, send email and play music online). Hence, the server of Gruber et al. necessarily comprises Applicant's *enabling* software.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a data store accessible to the server and storing information about individuals or families, pre-qualified for donations and *associated each* with a specified account with a financial institution...", however, it is unclear what the Applicant means by "associated each".

Claims 2-12 are also rejected as they depend from claim 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7 and 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gruber et al., US Patent Application Publication 2002/0029179.

As per claims 1, 4, 5, 13, 16 and 17, Gruber et al. teach a system for direct donation comprising:

- server accessible by potential donors (figure 1)
- data store accessible to the server and storing information about recipients pre-qualified to receive donations (figures 1, 2, and 8-10)
- software suite enabling a donor to view information about recipients and enabling a donor to make a donation to the selected recipient (figures 2 and 8-10)
- setting up accounts for donors and recipients interacting with a financial institution for crediting a recipient account and debiting a donor account (figures 5 and 6)

Gruber et al. do not specifically recite individuals or families. However, to one of ordinary skill, a charitable organization can be a large (e.g. UNICEF), a single individual, or any size in-between (figures 8 and 9), therefore the prior art at least suggests storing information about recipients such as individuals or families.

As per claims 2 and 14, Gruber et al. teach a system for making donations over the internet (figures 1, 2 and 8-10). Gruber et al. also teach displaying recipients (figures 3 and 5), "clicking on a recipient" (figure 3), and learning more about a recipient at a recipient's webpage (page 3, paragraph 37). Hypertext and hyperlinks are old and well known. Therefore, it would have been obvious to one of ordinary skill to construct a web document where a user can click on a recipient and be transferred to a webpage where a user can learn more about the selected recipient.

As per claims 3 and 15, Gruber et al. teach a system for making donations over the internet (figures 1, 2 and 8-10). Specifically, users interacting with the Gruber et al. system communicate with a server (figure 1; page 2, paragraph 33). A well-known method for connecting with a server is via IVR.

As per claims 6, 7, 18 and 19, Gruber et al. teach a system for making donations over the internet (figures 1, 2, and 8-10). Gruber et al. also teach setting up accounts for donors and recipients and interacting with a financial institution for crediting a recipient account and debiting a donor account (figures

5 and 6). Regarding viewing accounts, once a client as set-up an account with a financial institution, such as a bank, it is well-known that said client has access to said account. Gruber et al. disclose tax-exempt entities such as charities and nonprofit organizations (page 3, paragraphs 33 and 36). In order to qualify as "tax-exempt", an organization must file with the IRS to determine eligibility under 501(c)(3). Therefore, it would have been obvious to one of ordinary skill to make this information available to donors on the recipient's webpage in order to encourage said donor to make donations (page 3, paragraphs 36 and 37)

9. Claims 8-12 and 20-24, are rejected under 35 U.S.C. 103(a) as being unpatentable over Gruber et al., US Patent Application Publication 2002/0029179 and Cohen, U.S. Patent No. 6,422,462.

As per claims 8-12 and 20-24, Gruber et al. teach a system for making donations over the internet (figures 1, 2 and 8-10). It is well known to those of ordinary skill in charitable giving and charitable organizations to donate monetary and non-monetary gifts. However, Gruber et al. do not specifically recite redeemable documents associated with an identity for redeeming a donation. Cohen teaches a system for creating redeemable and non-transferable cards comprising creating virtual identities for a recipient which must be associated with the redeemable card to implement redemption (abstract; column 3, lines 18-27; column/line 3/55-4/11; column 5, lines 10-16; column/line 7/65-8/57; column 10,



4-13; column/line 11/57-12/15; column 13, lines 38-62). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Gruber et al. and Cohen in order to prevent an organization from using a donor's gift in a manner other unauthorized by the donor ('462, column/line 7/65-8/58).

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

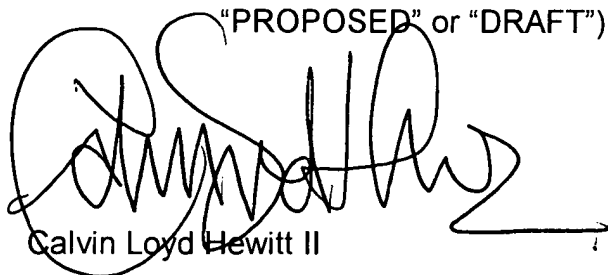
or:

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(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

A handwritten signature in black ink, appearing to read "Calvin Hewitt II", is written over the word "PROPOSED". The signature is stylized with large loops and a long horizontal stroke at the end.

Calvin Loyd Hewitt II

January 3, 2006